UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,556	03/21/2001	Eiichi Ito	108863	2650

25944 7590 04/01/2005

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER	
LUGO, CARLOS	

ART UNIT	PAPER NUMBER
3676	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/812,556	ITO ET AL.	
	Examiner	Art Unit	
	Carlos Lugo	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *1-12,14,15 and 17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13,16 and 18-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on December 16, 2004.

Election/Restrictions

2. Applicant's election with traverse of Group 2 in the reply filed on December 16, 2004 is acknowledged. The traversal is on the ground(s) that the amendments made to the claims were not extensive and the claims were previously twice examined by the examiner. It is further alleged that the withdrawn claims are sufficiently related to the remaining claims such that consideration of one would entail consideration of the other. This has not been found to be persuasive.

First of all, applicants' should note that restriction may be required at any time that it is proper (note MPEP 811). Second, patentability for methods is based upon consideration of the recited method steps whereas patentability for a product or apparatus is based upon the recited structure irrespective of methods steps. Thus, it is readily apparent that two different sets of criteria for patentability must be considered and the favorable patentability determination of one of the instant inventions does not inherently result in the other invention being patentable. Third, it has become increasingly burdensome on the examiner to keep both distinct inventions in the same application. Fourth, while applicants allege that the inventions are "sufficiently related", no basis to support this allegation has been set forth and it is not seen by the examiner as to how consideration of one invention requires consideration of the other, especially considering that patentability determination for

each invention relies on different criteria as previously noted above. Finally, it is noted that applicants do not specifically point out any errors in the restriction requirement itself. Therefore, the requirement is still deemed proper and is therefore made FINAL.

3. Claims 1-12,14,15 and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 16, 2004.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 13 and 16 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Rubber Stamps.com (Rubber Stamps) as modified by US Pat No 6,134,548 to Gottsman et al (Gottsman), in view of US Pat No 6,594,642 to Lemchen and further in view of US Pat No 6,161,099 to Harrington et al (Harrington).

Regarding claim 13, Rubber Stamps discloses a method of providing a personalized product in response to each request from customers. The method comprises the steps of:

A) receiving electronic personalized product producing data in first format and customer identification information (email order, Page 2).

B) electronically sequentially storing sets of the personalized product producing data and the customer identification information, each set including a piece of personalized product producing data and a piece of customer identification information (every time an user enter their information in the website).

C) producing the personalized product.

However, Rubber Stamps fail to disclose that the method comprises the steps of:

a) the data is received by a wireless communication.

b) electronically analyzing each piece of electronic personalized product producing data in the first format and converting it to a piece of electronic data in a second format.

c) receiving the piece of data in a second format and recording the piece of data in the second format on an output medium used to produce a personalized product.

d) automatically notifying the customer of completion of the personalized product requested.

Regarding the limitation presented in "a", Gottsman teaches that it is well known in the art to use a wireless communication in order to shop or communicate.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a wireless communication, as taught by Gottsman, into a system as described by Rubber Stamps, in order to give the customer different ways so as to be connected with the system.

As to the limitation presented in "b and c", Rubber Stamps discloses that the company can receive an email of the product and the company will create it. However, Rubber Stamps does not disclose the process from the point of receiving the email up to the final product.

Lemchen teaches that it is well known in the art to have an electronic data analyzer (50) that receives customize data from a web server (60). This data is then converted into electronic data (machine codes) that the personalized product-producing device (10) receives in order to create a product.

It would have been obvious to one ordinary skill in the art at the time the invention was made to have used an automated process, as taught by Lemchen, with the system as described by Rubber Stamps, in order to properly read the data of the customize desire product suministrated by the customer into the device that will create the desire product.

As to the limitation presented in "d", Rubber Stamps discloses that the company asks for customer information, e.g., postal address, phone number and email. However, Rubber Stamps fails to disclose that the company will send an email notification once the product is completed.

Harrington teaches that is well known in the art to utilize an email transmitter to transmit an email to a customer once something is completed (when the auction is completed, an email will be sent to the customer to notify him/her whether they won or lost the auction, Col. 12 Lines 24-30).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Rubber Stamps with an email returning device, as taught by Harrington, in order to provide an increased level of courtesy and customer service to the customer by promptly notifying him of completion of his order.

As to claim 16, Rubber Stamps discloses the step of delivering the personalized product produced to a location designated by each piece of customer identification information.

6. **Claim 18 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Rubber Stamps.com (Rubber Stamps) in view of US Pat No 6,134,548 to Gottsman et al (Gottsman), in view of US Pat No 6,594,642 to Lemchen and further in view of US Pat No 6,161,099 to Harrington et al (Harrington) as applied to claim 13 above, and further in view of US Pat No 6,535,294 to Arledge et al (Arledge).

Rubber Stamps, as modified by Gottsman, Lemchen and Harrington, fails to disclose that the system further includes a storage device that storages the produced personalized product in association with the customer information.

Arledge teaches that is known in the art to have a personalized product producing system wherein when an user already use the system to create a personalized product, the system includes a storage device (224) in order to store any information concerning the user and previously products created by the user (Col. 2 Line 66 to Col. 3 Line 6 and Col. 13 Lines 14-32).

It would have been obvious to one having ordinary skill in the ad at the time the invention was made to provide a storage device, as taught by Arledge, with the system as described by Rubber Stamps, as modified by Gottsman, Lemchen and Harrington above, in order to store desire information about the user for future purchases.

7. **Claims 19 and 20 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Rubber Stamps.com (Rubber Stamps) in view of US Pat No 6,134,548 to Gottsman et al (Gottsman), in view of US Pat No 6,594,642 to Lemchen, in view of US Pat No 6,161,099 to Harrington et al (Harrington) and further in view of US Pat No 6,535,294 to Arledge et al (Arledge) as applied to claims 13 and 18 above, and further in view of US Pat No 6,324,521 to Shiota et al (Shiota).

Rubber Stamps, as modified by Gottsman, Lemchen, Harrington and Arledge, fails to disclose that the automated method comprises at least the producing and the storing paired in each of a plurality of locations and that each piece of e-mail received from each of the customers contains information about the personalized product producing device's location, designated by each of the customers. Rubber Stamps, as modified by Gottsman, Lemchen, Harrington and Arledge, only discloses that the data is analyzed and transferred to the product-producing device.

Shiota teaches that it is well known in the art to have a system wherein the customer request a service wherein the customer can select the producing location and that each location includes the storing and producing as a pair (Col. 7 Line 45 to Col. 3 Line 62, Figures 1 and 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Rubber Stamps, as advanced above, with an ability wherein the customer can select the producing location and each location includes the storing and producing as a pair, as taught by Shiota, in order to have a system which can provide a prompt service to the customer.

8. **Claim 20 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Rubber Stamps.com (Rubber Stamps) in view of US Pat No 6,134,548 to Gottsman et al (Gottsman), in view of US Pat No 6,594,642 to Lemchen and further in view of US Pat No 6,161,099 to Harrington et al (Harrington) as applied to claim 13 above, and further in view of US Pat No 5,495,430 to Matsunari et al (Matsunari).

Rubber Stamps, as modified by Gottsman, Lemchen and Harrington, fails to disclose that the system includes a calculating service that calculates or estimates, upon receipt of the communication from the customer, a time of completion.

Matsunari teaches that it is well known in the art to have a calculating service that can give a customer an estimated time of how long it will take to produce the product (Col. 3 Line 20 to Col. 5 Line 19).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a calculating service that calculates an estimate time of production, as taught by Matsunari, into a device as described by Rubber Stamps, as modified by Gottsman, Lemchen and Harrington, in order to give the customer an estimated time of how long it will take to produce the product.

Response to Arguments

9. Applicant's arguments filed on December 16, 2004 have been fully considered but they are not persuasive.

As to applicant's arguments that Rubber Stamps, as modified by Gottsman, Lemchen and Harrington, fail to disclose the invention as claimed in claims 13 and 16 (Page 11 Line 19), the rejection is maintained. Rubber Stamps disclose substantially the invention as claimed. Gottsman, Lemchen and Harrington are only used to show that it is well known in the art to have the concept of receive the data by a wireless communication (Gottsman), to electronically analyzing each piece of electronic personalized product producing data in the first format and converting it to a piece of electronic data in a second format and receiving the piece of data in a second format and recording the piece of data in the second format on an output medium used to produce a personalized product (Lemchen) and to automatically notifying the customer of completion of the personalized product requested (Harrington). Therefore, Rubber Stamps, as modified by the concepts presented by Gottsman, Lemchen and Harrington, discloses the invention as claimed.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747 or 571-272-7058 (after March 31, 2005). The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

C.L.

Carlos Lugo
AU 3676

March 22, 2005.

Daniel P Stodola

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600